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26M1/1217

EXAMINER

PRESSON, T.

ART UNIT

2601

PAPER NUMBER

10

DATE MAILED: 12/17/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 10-6-96

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

BEST AVAILABLE COPY

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

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PART III DETAILED ACTION

Section 112 Rejections

1. Claims 7 and 22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is rejected because line 1 recites "one of said first signal", however, claim 5 recites only a first signal. Thus the language "one of..." is ambiguous since it implies there is a plurality of first signals.

Claim 22 is rejected because line 13 recites a broadcast or cablecast signal to a one of a control signal detector **and** a digital detector. Examiner is unable to ascertain how the signal can go to one of two detectors when the conjunction "and" is used, it appears that "or" is the proper conjunction.

Claim 8 is rejected because it depends upon claim 7.

Section 102 Rejections

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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15 and 16 are
2. Claims ~~15 is~~ ^{15 and 16 are} rejected under 35 U.S.C. § 102(b) as being anticipated by Skerlos, U.S. patent number 4,461,032. Skerlos teaches a first signal and identification data are stored in a cable television service controller. The signal is modified when sent through the filter element. (See column 3, lines 27-31; figure 1.)

*Add ** *Regarding claim 16, the signal sent through the filter element is a TV signal (col. 2, lines 31 and 34). TV signal inherently contains audio and video portions ("combined medium presentation").*

20 and 21 are
3. Claims ~~20 is~~ ^{20 and 21 are} rejected under 35 U.S.C. § 102(b) as being anticipated by "9 Digital Television developments", by Green et al. Figure 5 in Green shows a Teletext Data Bridge (first receiver station), a received signal (e.g. teletext signal and video signal). The received signal is stored in the storage "STORE". The signal is modified because the teletext signal is re-timed and re-inserted into a second video signal. The second video signal is outputted from the Teletext Data Bridge, to a second receiver station.

*Add ** *Regarding claim 21, the discussion on page 22, col. 2, lines 4-8 indicates that the received signal is a video signal which includes teletext signal. As shown in Fig. 5, teletext signal includes a frame code (one or more control instructions).*
The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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4. Claim 2 is rejected under 35 U.S.C. § 102(e) as being anticipated by Cox, U.S. patent number 4,388,645. Cox discloses a plurality of intermediate stations which receive scheduling times from the origination. The intermediate station transmits the stored programming units to a plurality of receiver stations according to the scheduling time. (See Cox figs. 1 and 4; col.4, line 58.)

Section 103 Rejections

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 2-23 are rejected under 35 U.S.C. § 103 as being unpatentable over Gimple, U.S. patent number 4,430,731 in view of

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McCalley et al. U.S. patent number 4,829,372. Claim 2 recites a method for communicating programming to subscribers in a network. The network has at least one programming originating station, intermediate transmission stations and subscriber stations. The intermediate transmission station (ITS) receives programming from the origination station and retransmits it to the subscriber station(s). The rebroadcast is scheduled using a computer at the ITS to determine the time and subscriber station that receives a transmission. Gimple teaches a method of interactive communication from an originating station through an ITS to a subscriber station and from the subscriber station to the originating station via the RVDM. The ITS of claim 2 is referred to as a remote video data distribution module (RVDM) in the Gimple patent and performs the function of rebroadcasting transmissions from the originating station. The RVDM utilizes a microprocessor to schedule the broadcast to the subscriber station. (See 3:59-65) Although Gimple does not explicitly teach the limitation that the scheduled times differ from intermediate station to intermediate station, and it can only be assumed that the broadcasts from the RVDMS would not be simultaneous, McCalley specifically teaches that the broadcasts to subscriber stations is at the time the subscriber desires. It would have been obvious to one of ordinary skill in the art to combine Gimple and McCalley because McCalley merely teaches that

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the digital interactive communication system is accessible by a plurality of subscribers upon demand. Thus, the user is able to select the time of the transmission. This capability makes the system more user-friendly since the user is not confined to a preselected time for a broadcast but has the flexibility to choose when to view a broadcast.

Claim 3 recites similar limitations as recited in claim 2 and further recites the scheduling of a time or frequency to transmit the programming. The scheduling utilizes a computer and the transmission time varies from ITS to ITS. The Gimple patent teaches the network of claim 2. Gimple also shows a computer to control the RVDM. McCalley specifically teaches that the broadcast time to subscribers can vary. It would have been obvious to combine the structure of Gimple with the flexible programming schedule of McCalley for the reasons stated above.

Claim 4 recites the structure of claim 2 with the additional steps of scheduling a time and a channel or a frequency for transmission, communicating to a computer at each ITS and controlling the ITS. As stated above, Gimple teaches the originating station, subscriber station and RVDM with a computer. McCalley teaches a system that enables a subscriber to select the content and time of a broadcast. McCalley teaches that there are a plurality of video presentations, thus there are a plurality of

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channels to broadcast on. The motivation for combining Gimple with McCalley has been stated above.

Claims 5,15,17,20 and 23 recite a system similar to that recited in claim 2. Claims 5 and 15 further require that there is a first signal to control the ITS and a second signal which contains at least some of the mass media presentation. Gimple teaches the originating station, subscriber station and RVDM with a computer. Gimple also teaches the use of a plurality of signals (5:30-35; 6:44-50). However, McCalley specifically teaches a first signal on a narrowband control channel which broadcasts tuning information and a broadband channel which monitors a digital stream of information including digital packets representative of selected audio/video presentations. (McCalley 2:48-55) Thus, McCalley teaches a control signal and a content signal. The motivation for combining Gimple with McCalley has been stated above.

Claims 6,18 and 19 are rejected because Gimple and McCalley teach a transmission schedule for the broadcast to the subscriber station.

Claims 7 and 8 further limit claim 5 by requiring the selection of a first signal and a second signal. The Gimple and McCalley patents specifically teach an interactive system where a user may select the transmission from the originating station and to the originating station. As stated in the rejection of claim

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5, two signals are taught in McCalley, one is a timing control signal. Thus, the combination of Gimple and McCalley renders claims 7 and 8 obvious. (See rejection of claim 5 above)

Claims 9-11 and 16 are rejected because McCalley specifically teaches a mass medium presentation that includes video and audio. Claim 11 requires the output to be print. Print is an obvious form of output in view of McCalley's teaching of a telephone peripheral since a fax machine is merely another peripheral device. The motivation for combining Gimple with McCalley has been stated above.

Claim 12 further limits claim 5 by requiring the second signal to be modified on the basis of processor instructions. McCalley teaches that the second signal, i.e. the broadband presentation is dependent upon the processor instruction that determines the time and channel of the presentation.

Claims 13 and 14 are rejected because McCalley teaches the use of software for each server and specialized application software. It would have been obvious to one of ordinary skill in the art that signals could be modified by placing information into higher language code since that is an efficient means of controlling the signals. The motivation for combining Gimple with McCalley has been stated above.

Claims 21 and 22 are rejected because both Gimple and McCalley specifically teach that at least one signal is

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television or radio and there is a means for detecting control signals and there is a way to select a desired program.

Other Art Considered Relevant

6. Other art considered relevant to Applicant's specification but not used as basis of rejection includes:

Kauffman (4,710,955) which teaches a cable television system with two way telephone communication path.

Campbell (4,536,791) which teaches addressable cable television control system with video format data transmission.

Lambert (4,724,491) which teaches inserting television advertising spots automatically.

Lambert (4,381,522) which teaches selective viewing.

Robertson (4,052,737) which teaches a method and apparatus utilizing Baudot code for categorizing and distributing information to a plurality of utilization units.

Von Kohorn (4,745,468) which teaches a system for evaluating and recording responses to broadcast transmissions.

Gilhousen (4,712,238) which teaches selective subscription descrambling.

Oniki (4,626,909) which teaches video signal recording and reproducing system with automatic channel and time selection.

Jeffers (4,739,510) which teaches direct broadcast satellite signal transmission system.

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Presson whose telephone number is (703) 305-1876.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

TFP

Nov. 12, 1996